

REMARKS

Claims 1-5, 7-13, 15-23, and 25-36 are pending in the application. Claims 1, 4, 9, 12, 17, 20, 25, 28, 31, and 34 are independent. Claims 1-2, 9, 17, 20, 25, 28, 31-32, and 34-36 have been amended and claim 24 has been canceled. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 1, 3, 9-11, 17-19, and 31-33 Under 35 U.S.C. § 102(b)

In paragraph 1 of the Office Action, the Examiner rejected claims 1, 3, 9-11, 17-19, and 31-33 under 35 U.S.C. §102(b) as being anticipated by “PCI Standard Hot-Plug Controller and Subsystem Specification” Revision 1.0, dated June 20, 2001 (hereinafter “SHPC Specification”). A claim is anticipated only if each and every element of the claim is found in a reference. (MPEP §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id.* citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Applicants respectfully traverse the rejection.

In paragraph 3 of the Office Action, the Examiner states that the SHPC Specification discloses an apparatus comprising a hot-plug controller having a blinking pattern controller to receive at least one command and to cause execution of a blinking pattern on at least one indicator associated with a target PCI slot on a PCI bus, the blinking pattern being unique to the command being processed, wherein a first unique blinking pattern is to indicate a first command to turn the indicator “on” solid. Applicants respectfully disagree.

Applicants respectfully submit that the SHPC Specification fails to show the identical invention as that of the claimed invention. Amended claim 1 recites in pertinent part “wherein a first unique blinking pattern is to indicate a first ***command to turn the indicator “on” solid***; and cause execution of a second blinking pattern on the at least one indicator associated with the at least one target peripheral component interconnect slot on the peripheral component interconnect bus, wherein the second unique blinking pattern is to indicate a second ***command to turn the indicator “off,”*** wherein the ***first unique blinking pattern is different from the second unique blinking pattern***” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicants’ Specification at paragraph [0058].

The SHPC Specification is clear that the power indicator has one of three states: on, off, or blinking. When the power indicator is blinking, it is indicating that the slot is powering up or powering down and an adapter card cannot be safely inserted or removed from the slot. There is no indication in the SHPC Specification either expressly or inherently that there is a different blinking pattern for indicating when the slot is powering up versus powering down. Thus the SHPC Specification fails to the identical invention as recited in claim 1 and as a result does not anticipate claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claim 1.

Claim 3 properly depends from claim 1, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claim 3 is patentable for at least the same reasons that claim 1 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 3.

In paragraphs 5 and 9 of the Office Action, the Examiner essentially states that the SHPC Specification discloses receiving a command at a SHPC from a microprocessor and causing execution receiving a command at a standard hot-plug controller from a microprocessor; and causing execution of a blinking pattern on at least one indicator associated with at least one target peripheral component interconnect slot on a peripheral component interconnect bus, the blinking pattern indicating the command being processed, the blinking pattern having a duty cycle that is less than or greater than approximately fifty percent. Applicants respectfully disagree.

Applicants respectfully submit that the SHPC Specification fails to show the identical invention as that of the claimed invention. Amended claims 9, 17, and 31 recite in pertinent part “the blinking pattern having a duty cycle that is less than or greater than approximately *fifty percent ±5%*” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicants’ Specification at paragraph [0058].

The SHPC Specification is clear at Section 2.2.1 that “Blinking indicators operate at a frequency of 1 to 2 Hz and 50% ($\pm 5\%$) duty cycle. That is, while the SHPC Specification calls for the indicators to blink at a 50% ($\pm 5\%$) duty cycle embodiments of the present invention according to claims 9, 17, and 31 may be implemented wherein the indicators are to blink at a duty cycle that is *less than or greater than* approximately *fifty percent $\pm 5\%$* ” Thus the SHPC Specification fails to the identical invention as recited in claims 9, 17, and 31 and as a result does not anticipate claims 9, 17, and 31. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 9, 17, and 31.

Claims 10-11 properly depend from claim 9, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 10-11 are patentable for at least the same reasons that claim 9 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 10-11.

Claims 18-19 properly depend from claim 17, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 18-19 are patentable for at least the same reasons that claim 17 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 18-19.

Claims 32-33 properly depend from claim 31, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 32-33 are patentable for at least the same reasons that claim 31 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 32-33.

Rejection of Claims 2, 25-30 and 34-36 Under 35 U.S.C. §103(a)

In paragraph 11 of the Office Action, the Examiner rejected claims 2, 25-30, and 34-36 as obvious over the SHPC Specification in view of “PCI Express to PCI/PCI-X Bridge Specification” Revision 1.0, dated July 14, 2003 (hereinafter “PCI Express Bridge Specification”). To establish a *prima facie* case of obviousness, an Examiner must show that that

there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teach each and every element of the claimed invention. (MPEP §2143.) Applicants respectfully traverse the rejection.

Claim 2 properly depends from claim 1, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claim 2 is patentable for at least the same reasons that claim 1 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 2.

Applicants respectfully submit that the SHPC Specification in view of the PCI Express Bridge Specification fails to show each and every element as that of the claimed invention. Amended claims 25 and 28 recite in pertinent part “the blinking pattern having a duty cycle that is less than or greater than approximately **fifty percent $\pm 5\%$** ” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicants’ Specification at paragraph [0058].

The SHPC Specification is clear at Section 2.2.1 that “Blinking indicators operate at a frequency of 1 to 2 Hz and 50% ($\pm 5\%$) duty cycle. That is, while the SHPC Specification calls for the indicators to blink at a 50% ($\pm 5\%$) duty cycle embodiments of the present invention according to claims 25 and 28 may be implemented wherein the indicators are to blink at a duty cycle that is **less than or greater than** approximately **fifty percent $\pm 5\%$** .” The PCI Express Bridge Specification fails to make up for this deficiency. The PCI Express Bridge Specification appears to be directed to “a connection path between two independent PCI busses” (Section 1.2) and appears not to be concerned with the PCI slot indicator blinking patterns. Thus the combination of SHPC Specification in view of the PCI Express Bridge Specification fails to teach or fairly suggest each and every element recited in claims 25 and 28 and as a result does not render obvious claims 25 and 28. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 25 and 28.

Claims 26-27 properly depend from claim 25, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 26-27 are patentable for at

least the same reasons that claim 25 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 26-27.

Claims 29-30 properly depend from claim 28, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 29-30 are patentable for at least the same reasons that claim 28 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 29-30.

Amended claim 34 recites in pertinent part “wherein a second unique blinking pattern is to indicate a *second command different from the first command*, wherein the *first unique blinking pattern is different from the second unique blinking pattern*” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicants’ Specification at Figures 4-15 and accompanying description.

As discussed above, there is no indication in the SHPC Specification either expressly or inherently that there is a different blinking pattern for indicating and the PCI Express Bridge Specification fails to make up for this deficiency because it appears not to be concerned with the PCI slot indicator blinking patterns. Thus the combination of SHPC Specification in view of the PCI Express Bridge Specification fails to teach or fairly suggest each and every element recited in claim 34 and as a result does not render obvious claim 34. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claim 34.

Claims 35-36 properly depend from claim 34, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 35-36 are patentable for at least the same reasons that claim 34 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988))). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 35-36.

Rejection of Claims 20 and 22-23 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 20 and 22-23 as obvious over the SHPC Specification in view of U.S. Patent No. 6, 772, 018 to Juntunen et al. (hereinafter "Juntunen"). Applicants respectfully traverse the rejection.

Although Applicants believe that claim 20 is patentable as written, in the interest of expediting prosecution, applicants have amended claim 20 to include the subject matter of claim 24. The Examiner indicated that claim 24 would be allowable if rewritten in independent form to include all limitations of claim 20. Accordingly Applicants respectfully submit that claim 20 is now in condition for allowance and respectfully request that the Examiner reconsider and remove the rejection to claim 20.

Claims 22-23 properly depend from claim 20, which Applicants respectfully submit is in condition for allowance. Accordingly, Applicant respectfully submits that claims 22-23 are in condition for allowance for at least the same reasons that claim 20 is in condition for allowance. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988)). Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 22-23.

CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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